

II. Remarks

A. Rejections Under 35 U.S.C. §112.

The Examiner states that “the instant specification limits the invention to products that are firm, malleable enough to allow cleat penetration and easy repair, resistant to being pulled up in clumps, dust free and water resistant.” Applicant disagrees that the claimed inventions are limited as the Examiner states, but regardless, it is not necessary to list benefits of the invention in the claims and the Examiner has not cited any authority for this proposition. Thus, in view of the discussion below regarding the term “wax,” it is submitted that the scope of the claims as written is enabling to one skilled in the art.

Based on the amendment to claim 37, the rejection based on the Examiner’s comment that claims must include “wax” and “clay” is believed to be traversed. Furthermore, this amendment traverses the Examiner’s comment that claiming desired physical properties alone is itself indefinite, although Applicant disagrees that this is an accurate statement of the law. Claims 13 – 36 have been amended and are now believed to properly depend from claim 12.

The Examiner takes the position that since the specification recites two waxes that can be used in the practice of the invention, the invention is limited to using these particular waxes. No legal or factual authority is cited to support this proposition, even though the burden is on the Examiner to provide such reasoning. MPEP § 2164.04 (the examiner has the initial burden to establish a reasonable basis to question enablement). It is incumbent upon the Examiner to explain why he doubts the accuracy of the support in the disclosure and to back up such assertions with acceptable evidence or reasoning. Id. The examiner should specifically identify what information is missing and why one skilled in the art could not supply the information without undue experimentation. Id. The first Office Action on the merits should present the best case with all the relevant reasons, issues and evidence. Id. (A)

Applicant respectfully submits that the arguments in the Office Action lack any specific reasoning as to why one skilled in the art could not practice the full scope of the claimed inventions without undue experimentation. In fact, the passage referenced by the Examiner at page 6, lines 12 – 16 states: “The purpose of the wax is to make the surface material malleable and to add cohesiveness between the particles... Any wax capable of performing these functions may be used. (Emphasis added). Since claim terms are interpreted using the specification as a guide, one skilled in the art would understand that the claimed wax must make the surface material malleable and add cohesiveness between the particles. Further, based on the teachings of the present specification, one skilled in the art could make and use the full range of the claimed invention without undue experimentation. See MPEP § 2164.06. (B)

Therefore, the claims are enabled by the specification.

B. Rejections Under 35 U.S.C. §102.

1. U.S. Patent Nos. 5,961,389, 4,925,413 and 5,711,795.

These references fail to teach at least the properties recited in claim 37 and the Examiner has not presented any evidence or reasoning to explain how such properties are inherent in any of these references. Thus, the rejection cannot stand and Applicant submits that claim 37 (now amended) is not anticipated by any of the cited references. (4)

Further, as explained in the present specification (page 1, lines 16-23) "sand" and "decomposed granite" are not indistinguishable.

III. Conclusion.

In view of the amendments and arguments herein this Application is believed to be in condition for allowance and favorable action is requested. Applicant reserves the right to prosecute additional claims, including claims of broader scope, in a continuation application. (b)

The Examiner is invited to telephone the undersigned at the telephone number listed below if it would in any way advance prosecution of this case.

Respectfully submitted,

1-27-03
Date

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EXHIBIT A

Amended Claims

13. The [method] surface material of claim 12 wherein the wax is emulsified in water.
14. The [method] surface material of claim 13 wherein the wax is liquid while emulsified.
15. The [method] surface material of claim 14 wherein the wax is a microaryotalline based slack wax.
16. The [method] surface material of claim 12 wherein the surface material is dried after the clay and emulsified wax are mixed.
17. The [method] surface material of claim 12 that further comprises the step of placing a layer of the surface material on a surface.
18. The [method] surface material of claim 17 wherein the layer is between 2" and 6" deep.
19. The [method] surface material of claim 17 wherein the surface material is dried before placing it on the surface.
20. The [method] surface material of claim 17 that further includes the step of transporting the surface material prior to placing a layer on the surface.
21. The [method] surface material of claim 20 wherein the mixture is at least partially covered with a moisture-proof barrier during the step of transporting.
22. The [method] surface material of claim 12 wherein the surface material further comprises decomposed granite and is made by the method of mixing decomposed granite, clay and emulsified wax.
23. The [method] surface material of claim 12 wherein neither the clay nor the wax are heated prior to or during the mixing step.

24. The [method] surface material of claim 21 wherein the moisture-proof barrier is comprised of plastic.
25. The [method] surface material of claim 12 wherein, the emulsified wax is placed onto a surface comprising clay prior to mixing the clay and emulsified wax.
26. The [method] surface material of claim 12 wherein the surface material further comprises silt and is formed by the method of mixing silt, clay and emulsified wax.
27. The [method] surface material of claim 25 that further includes the step of mixing the wax with the surface material to form a mixture.
28. The [method] surface material of claim 25 wherein the mixing is done by tilling the mixture by hand.
29. The [method] surface material of claim 25 that further includes the step of compressing the mixture of wax and surface material.
30. The [method] surface material of claim 29 wherein the mixture is compressed using a roller.
31. The [method] surface material of claim 25 wherein neither the soil material nor the emulsified wax is heated prior to or during mixing.
32. The [method] surface material of claim 12 wherein the surface material includes gravel.
33. The [method] surface material of claim 12 wherein the surface material includes organic binder.
34. The [method] surface material of claim 33 wherein the organic binder is dried and ground plantago.
35. The [method] surface material of claim 34 wherein the dried and ground plantago consists of 80% or more plantago husk.

36. The [method] surface material of claim 25 wherein the surface material is part of a pitcher's mound.

37. A surface material comprising wax and clay and having the following properties:

- (a) A dry density of between 100 and 115 lbs/ft; and
- (b) An unconfined compressive strength of between 10 and 100 psi, wherein there is not brittle failure of the surface material.

Please delete claims 39 and 40.